

## **Remarks/Arguments**

### **I. STATUS OF THE CLAIMS**

Claims 2-37 and 39-75 are pending in this application. Claims 1, 17, 38 and 55 have been cancelled. Claims 2, 18-24, 31, 37, 39, 40, and 56-62 have been amended to change their dependency. Claims 3, 12, 34, 41, 50, and 72 have been put into independent form. Claim 12 has been further amended to include features previously recited in claim 17. Claim 50 has been further amended to include features previously recited in claim 55. The numbering for claims 62-75 have been corrected, having previously been misnumbered. Claims 7, 18-20, 45, and 56-58 have been amended for clarity to address an objection raised by the Examiner. Claims 32 and 70 are amended to correct a typographical error.

### **II. OBJECTIONS TO THE CLAIMS**

The Examiner objected to the misnumbering of claim 62 and the claims thereafter. The numbering has been corrected.

Claims 7, 18-20, 45, and 56-58 were objected to by the Examiner as having some phraseology that was difficult to understand. Those claims have been amended in the manner suggested by the Examiner.

### **III. Rejections Under 35 U.S.C. § 112**

Claims 7, 8, 18-20, 45, 46, and 56-58 stand rejected under 35 U.S.C. § 112 as being indefinite based on use of the phrase, "may, or may not." Applicants submit that this rejection should be withdrawn because there is nothing indefinite about this phrase. In the context of the claims, the phrase is used as a limitation describing a rule that controls whether a particular document "may, or may not" be combined in some way with another document. The phrase in question is used in its common English manner.

The use of the alternative, “or,” does not create indefiniteness. MPEP 2173.05(h) II. The phrase is meant to convey that the recited rule may be phrased in either a permissive, or a restrictive, manner. For example, it would be undesirable to allow an infringer to arguably design around the claim simply by recasting the rule as restrictive (making a rule that combination is not allowed), if the claim only recited “may.”

Accordingly, while the phrase, “may, or may not” does broaden the scope of the claims, there is nothing indefinite about it, and the rejection may be withdrawn.

Claims 8 and 46 is further rejected for using the phrase “and/or.” Applicants submit that this rejection should also be withdrawn because this is another commonly used phrase about which there is nothing indefinite. As discussed above, the use of the alternative “or” is not indefinite. MPEP 2173.05(h) II. This phrase means that either, or both, of the items identified can satisfy the claim limitation. Simply saying “and” would require both items. Simply saying “or” might be argued to mean only one of the items. Thus the phrase is meant to be inclusive of both concepts. Applicants further note that the phrase “and/or” commonly appears in patent claims issued by the USPTO. A search for the phrase on the USPTO online database indicates more than 135,000 patents that include that phrase in the claims.

Accordingly, while the phrase, “and/or” does broaden the scope of the claims, there is nothing indefinite about it, and the rejection may be withdrawn.

#### **IV. Prior Art Rejections**

##### **Rejections Under 35 U.S.C. § 102(b)**

Pending claims 2-6, 12-16, 21-24, 31, 34, 36, 37, 39-41, 50-54, 59-62, 72, 74, and 75 stand rejected as anticipated under 35 U.S.C. § 103(b) by U.S. Patent 5,058,030 to Schumacher, (“Schumacher”).

##### *Claims 2-6 and 39-41*

Claims 2-6, as amended, now all depend from independent claim 3. Claims 39-41, as amended, all depend from independent claim 41. Claims 3 and 41 both recite a

“customer relationship management system” (CRM) used for “determining at least some of the first and second criteria” used in connection with consolidating and production routing. An exemplary CRM system is depicted at ref. 3 in Fig. 1, and the corresponding text. See, e.g., page 10, line 8, to page 12, line 8.

It is submitted that Schumacher does not disclose the recited customer relationship management system, nor the use of that system for determining the respective first and second criteria. Accordingly, the rejections of these claims 2-6 and 39-41 may be withdrawn.

*Claims 12-16, 21-24, 31, 50-54, 59-62*

Claims 12-16, 21-12 and 31, as amended, now all depend from independent claim 12. Claim 12 further includes subject matter previously recited in claim 17. Claims 50-54 and 59-62, as amended, now all depend from independent claim 50. Claim 50 now includes subject matter previously recited in claim 55. Both claims 12 and 50 recite a “statement applications processing module” for “determining at least some of the first and second criteria.” Those claims also recite that the first and second criteria include “sender rules received from the statement applications processing module.” An exemplary statement applications processing module” is depicted at ref. 5 in Fig. 1, and the corresponding text. See, e.g., page 12, line 9, to page 13, line 8.

It is submitted that Schumacher does not disclose these recited features. Schumacher does not describe sender rules including the first and second criteria for consolidation and production routing generated at a statements applications processing module. Accordingly, the rejection of these claims may be withdrawn.

*Claims 34, 36, 37, 72, 74, and 75*

Claims 36 and 37 depend from indent claim 34. Claims 74 and 75 depend from independent claim 72. Independent claims 34 and 72 each recite the optimal site routing be based on “historical site production data.” This feature is not disclosed in Schumacher. Accordingly, the rejections of these claims may be withdrawn.

### **Rejections Under 35 U.S.C. § 103(a)**

#### Rejections based on Schumacher alone.

Pending claims 7, 18, 19, 32, 33, 35, 42-45, 56, 57, 70, 71 and 73 are rejected as obvious in view of Schumacher alone.

Claims 7, 18, 19, 32, 33, 35, 42-45, 56, 57, 70, and 73 all depend from independent claims discussed above. Because Schumacher fails to disclose or suggest the identified features of the independent claims, these dependent claims should be allowable for the same reasons.

#### *Claims 7 and 45*

These claims recite marketing rules that are used to determine whether messages with particular marketing content may, or may not, be combined. The Examiner, has acknowledged that Schumacher does not disclose these features, but asserts that known privacy considerations would have made those features obvious. Even assuming that the unsupported motivation of “privacy” existed, there is no nexus between the alleged privacy considerations and the feature recited in the claims. The claims are directed to whether particular marketing content can be consolidated. There is no privacy concern that is being addressed by these features. Accordingly, the Examiner has not identified any prior art, or any relevant basis, for finding that these features were known, or obvious.

#### *Claims 18 and 56*

These claims recite a sender rule that determines whether messages with particular business content may, or may not, be combined. The Examiner, has acknowledged that Schumacher does not disclose these features, but asserts that known privacy considerations would have made those features obvious. Even assuming that the unsupported motivation of “privacy” existed, there is no nexus between the alleged privacy considerations and the feature recited in the claims. The claims are directed to whether particular business content can be consolidated. There

is no privacy concern that is being addressed by these features. Accordingly, the Examiner has not identified any prior art, or any relevant basis, for finding that these features were known, or obvious.

For at least these reasons, it is submitted that the obviousness rejections of these claims based on Schumacher alone should be withdrawn.

#### Rejections based on Schumacher and Johnson

Claims 8-11, 20, 46-49 and 58 stand rejected under 35 U.S.C. § 103(a) as obvious over Schumacher in view of U.S. publication 2004/0230523 to Johnson ("Johnson"). These rejected claims all depend from independent claims that are should be allowable over Schumacher for the reasons given above. Johnson fails to cure the deficiencies identified above for those independent claims. Thus these rejections should be withdrawn for the same reasons.

#### Rejections based on Schumacher and Stepno

Claims 25-27, 29, 63-65 and 67 stand rejected under 35 U.S.C. § 103(a) as obvious over Schumacher in view of U.S. publication 2002/0133472 to Stepno ("Stepno"). These rejected claims all depend from independent claims that are should be allowable over Schumacher for the reasons given above. Stepno fails to cure the deficiencies identified above for those independent claims. Thus these rejections should be withdrawn for the same reasons.

#### Rejections based on Schumacher, Stepno, and Johnson

Claims 28, 30, 66, and 68 stand rejected under 35 U.S.C. § 103(a) as obvious over Schumacher in view of Stepno in further view of Johnson. These rejected claims all depend from independent claims that are should be allowable over Schumacher for the reasons given above. Stepno and Johnson fails to cure the deficiencies identified above for those independent claims. Thus these rejections should be withdrawn for the same reasons.

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**V. CONCLUSION**

For these reasons, it is submitted that claims 2-37 and 39-75 should be found allowable in view of the asserted references. It is respectfully submitted this application is in a condition for allowance. Please contact the undersigned representative if there are any questions regarding this application.

Respectfully submitted,

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